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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,660	02/01/2001	Sagahiro Taho	723-1006	3512

7590 09/12/2003

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EXAMINER	
WHITE, CARMEN D	

ART UNIT	PAPER NUMBER
3714	9

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/774,660	Applicant(s) TAHO ET AL.	
	Examiner Carmen D. White	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Miyamoto*** et al (6,132,315) in view of ***Tarr*** et al (6,238,290).

Regarding claims 1, 3, 6, 8-11,14-16,19-24, and 27-29, Miyamoto teaches a game information storage medium utilized for a first game machine having a first architecture that includes the features of the instant claims as it pertains to, in summary, a storage medium that can be used on a first and second game machine, without the machines having similar architecture and processing speeds (abstract; col. 1, lines 9-15 and lines 25-64; col. 2, lines 44-67; col. 3, lines 11-22; col. 4, lines 56-67; col. 7, lines 5-10; col. 7, lines 65-67 through col. 8, lines 1-3; col. 9, lines 45-47 and lines 63-65; col. 10, lines 54-65; col. 12, lines 4-24). Miyamoto further teaches game names/titles associated with the game programs (Fig. 10, #S15 and #S23; col. 21,lines 56-58). The emulator program is associated with the game programs. Therefore, it is also associated with the game names/titles of the programs. Miyamoto is silent regarding the explicit teaching of the feature of allowing the user to choose a game title. However, as acknowledged in the prior office action this is a well known feature in gaming machines. The game storage medium and graphics system of Miyamoto are

functionally capable of achieving this function. Tarr teaches the feature of a player selecting from a menu of game titles (Fig. 3). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature, as taught by Tarr, in Miyamoto to allow the player increased control and variety in the gaming experience. This would increase excitement and participation in the game.

Regarding claims 2, 4-5, 12, 17-18 and 25, Miyamoto and Tarr teach all the limitations of the claims as discussed above. Miyamoto is silent regarding the explicit disclosure of two game programs being stored on the storage medium. Miyamoto is also silent on the feature of two emulator programs. However, the examiner takes official notice that it is well known in the art to store multiple games and programs on a single storage medium. This makes the game system more efficient and versatile. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Miyamoto.

Regarding claims 7, 13 and 26, Miyamoto and Tarr teach all the limitations of the claims as discussed above. Miyamoto is silent regarding the explicit teaching of the preliminary information indicative of an outline of a game according to a program. However, Tarr teaches a game information and game title screen (Fig. 2, #48 and #72) It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature of Tarr in Miyamoto to increase play of the game and thereby increase game sales for the gaming company.

Claims 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Miyamoto*** et al (6,132,315).

Regarding claims 30-36, Miyamoto teaches all the limitations of the claims as discussed above and in the initial office action (paper #7), which is incorporated herein by reference. As recited in the initial office action, the feature of the selection of game program titles is well known (as can be seen in the Tarr et al reference above).

Examiner's Response to Applicant's Remarks

In response to applicant's argument regarding reasons the instant claimed invention uses an emulator program that executes a game for a game machine having a first architecture on another game machine having a second architecture as opposed to the reasons Miyamoto uses an emulator program, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant has amended the claims 1-29 to more clearly focus on the game title feature associated with the game programs. The examiner has addressed this newly amended feature, above, using the Tarr et al reference. The examiner asserts that Miyamoto and Tarr teach the limitations of the instant claims, which include the teaching of the selection of game titles (see above).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for Non-official communications and 703-305-3579 for Official communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

cdw

S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700